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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,395	02/02/2001	John Richard Skerrett	AFH-13782.1	2248

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EXAMINER

BUTLER, MICHAEL E

ART UNIT

PAPER NUMBER

3653

DATE MAILED: 12/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/776,395

Applicant(s)
Skerrett et al.

Examiner
Michael E. Butler

Art Unit
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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Sep 26, 2002

2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-8 and 17-24 is/are pending in the applica

4a) Of the above, claim(s) 17-24 is/are withdrawn from considera

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-8 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirem

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

4) ☐ Interview Summary (PTO-413) Paper No(s). _____

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) ☐ Notice of Informal Patent Application (PTO-152)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

6) ☐ Other: _____

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DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action, and apply to this and any subsequent Office Actions.

Priority

2. Applicant's claim(s) of priority as a divisional application 09/106978 (US Patent 6213346) filed 6/29/98 is acknowledged.

Drawings

3. New drawings will be required contingent upon allowance because the drawings were declared informal by the applicant.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-8 are rejected under 35 U. S. C. § 112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has created ambiguous range delineations (re: cl 1) about 20-40 gsm. It is not apparent how close to 20 gsm or 40 gsm something must be to be "about" 20 gsm or 40 gsm. Similarly, it is not apparent how close to the range limit: (re: cl 4) the napkin basis weight needs be to be about 30 gsm; (re: cl 6) machine direction tensile needs be to be greater than about 2000 g; (re: cl 7) T/S ratio needs be to be greater than about .3; (re:

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cl 8) tab strength needs be to be greater than about 30 gf. See MPEP 2173.05(c) II regarding open ended ranges.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States
- (c) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 1 and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Lloyd et al. which discloses:

(re: cl 1) napkin assembly comprising (p2 L 21-25):
first continuous napkin sheet having a plurality of napkins having basis weight of about 20-40 gsm (p2 L 45-47)
each napkin interconnected to the adjacent napkin by a plurality of tabs (Fig. 2, 22)
second continuous napkin sheet comprising a plurality of napkins each napkin comprising a plurality of sheets (p2 L 45-47)
first and second napkin sheets positioned proximate one another in nested formation (p3 L 44-47);
(re: cl 6) machine direction tensile is greater than about 2000 g (table 1)
(re: cl 7) T/S ratio is greater than about .03 (p3 L 25-27, derivable from the 1.5/11 ratio);
(re: cl 8) tab strength is greater than about 30 g-f. (p 3 L 24-26 for napkins at least 2.8 cm).

8. Claims 1, 4, and 6-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lloyd et al. '382 which discloses the elements previously discussed and further discloses:

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(re: cl 4) the napkin basis weight is about 30 gsm (p2 L 45-47, 25-35 gsm is or approximates "about 30 gsm").

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-2, 4, and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lloyd et al. '382 in view of Young et al. with Lloyd et al. '382 disclosing the elements previously discussed and further disclosing:

at least on napking terminates at about the fold of a respective napkin (fig 2);
Young disclosing the elements not explicitly taught by Lloyd et al. '382 of:
first member integrally formed with second member formed (c6 L 6-23).

It would have been obvious at the time of the invention to modify the Lloyd et al. with an integrally formed web of Young et al. because it is easier to cut a single web in an automated manufacturing system into plural webs than to assemble separate webs as taught by Young et al. and thereby come up with the instant invention.

11. Claims 1, 4, and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lloyd et al. '382 in view of Everhart with Lloyd et al. '382 disclosing the elements previously discussed and Everhart disclosing:

(re: cl 5) napkins comprise pulp fibers (c4 L 47).

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It would have been obvious for Lloyd et al. to use pulp fibers to make the napkins of pulp fibers because pulp based fibers are the most prevalent materials used in making paper, provide an absorbent paper, and are low priced as taught by Everhart and thereby come up with the present invention.

12. Claims 1, 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lloyd et al. '382 in view of Cook et al. with Lloyd et al. '382 disclosing the elements previously discussed and Cook et al. further disclosing:

(re: cl 4) the napkin basis weight is about 30 gsm (c 9 L 1-3);
(re: cl 5) napkins comprise pulp fibers (c4 L 47).
(re: cl 8) tab strength is greater than about 30 g-f. (c10 L 15-30).

It would have been obvious for Lloyd et al. '382 to use a napkin basis weight of about 30 gsm because thin napkins may be sold cheaper than heavier napkins as taught by Cook et al. and thereby come up with the present invention.

It would have been obvious for Lloyd et al. '382 to use pulp fibers to make the napkins of pulp fibers because pulp based fibers are the most prevalent materials used in making paper, provide an absorbent paper, and are low priced as taught by Cook et al. and thereby come up with the present invention

13. Claims 1, 3-4 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lloyd et al. '382 in view of Dwiggins et al. wherein Lloyd et al. '382 discloses the elements previously discussed and further discloses:

(re: cl 3) at least 300 napkins terminate proximate a fold between first and second members (c3 L 26-31);
at least one napkin from the first sheet terminates at the fold of the second sheet (c2 L 35-59); and Lloyd et al. '382.

Dwiggins et al. discloses the use of a stack size of 500 napkins (c24 table 10).

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It would have been obvious at the time of the invention to increase the stack size of Lloyd et al. '382 to 500 napkins because 500 sheet refill clips are available and need be refilled less frequently as taught by Dwiggins et al. thereby coming up with the instant invention.

Response to Amendments

14. Applicant's amendments were effective in distinguishing overcoming the rejections based upon Chan '554.

Response to Arguments

15. The applicant's arguments have been fully considered but they are unpersuasive in overcoming the rejections under 35 U.S.C. § 112.

In support of his position, applicant cites *Gore* and *Syntex* which were inter partes proceedings on actions with standing premised upon issued patents. When reviewing validity for indefiniteness of issued patents, courts are charged with preserving the presumption of validity. When a court finds multiple claim scopes under claim construction, a court must, rather than rule for indefiniteness, make a holding for a narrower interpretation of scope "to maintain the presumption of validity if possible so as to protect the inventive contribution of patentees, even when the drafting of their patents has been less than ideal." *Exxon Research and Engineering v. United States*, 60 USPQ2d 1272, 1276 (Fed. Cir. 2001); *Chemical Separation Technology Inc. v. United States*, 63 USPQ2d 1114 (USCt.Fed.Cls 2002). In ex parte proceedings before the USPTO, applicant's still have the opportunity to amend claims into compliance with the requirements of 35 U.S.C. § 112. *In re Etter*, 225 USPQ 1,5 (Fed. Cir. 1985). Such opportunity has generally lapsed after issuance and during infringement litigation.

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In construing the claims, the Syntex court reiterated the courts' duty to construe claims toward preserving patent validity. *Syntex, Inc. et al. v. Paragon Optical, Inc. et al.*, 7 USPQ2d 1001,1037 (D. Ariz. 1987) citing *ACS Hosp. Systems, Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577 [221 USPQ 929, 932-933] (Fed. Cir. 1984). Further, the approximating claim language in *Syntex* was used subordinated to "consisting essentially of" language which permits approximating deviations not materially effecting the novel characteristics of the balance of the rest of the claim. *Syntex* at 1037 citing *In re Garner*, 412 F.2d 276, 279 [162 USPQ 221, 223], (C.C.P.A. 1969). In *Syntex*, the court clearly delineated that the elements using approximating language were not material to novelty of the claim and not subject to further limitation through dependent claims. *Id.* at 1038. By contrast, in the instant case the applicant has further attempted to narrow the approximating range of the "basis weight" of claim 1 in claim 3; and applicant has used approximating ranges as the sole further limiting element in each of claims 6-8 -- clearly establishing applicant's intent at distinguishing novelty of the claims through range limitations of these material elements.

Further, inter parte proceedings require indefiniteness be established by clear and convincing evidence rather than the preponderance of evidence standard required in ex parte proceedings before the PTO. *Budde v. Harley-Davidson Inc.*, 58 USPQ2d 1801, 1806 (Fed. Cir. 2001); *Ultra-Tex Surfaces, Inc. V. Hill Bros. Chem. Co.*, 204 F.3d 1360, 1367, 53 USPQ2d 1892, 1898 (Fed. Cir. 2000); *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1570, 1 USPQ2d 1593, 1595 (Fed. Cir. 1987). "From *In re Etter* it is apparent that, due to 35 U.S.C. § 282, the standard of proof required to properly reject the

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claims of a patent application is necessarily lower than that required to invalidate patent claims.” *In re Caveney*, 761 F.2d 671, 674, 226 USPQ 1,3 (Fed. Cir. 1985).

Applicant also cites *Eastwood* which, while an ex parte proceeding, differed from the instant case in that the range variation language resided not on the claimed invention but on the object for use with the claimed invention. Contrary to applicant’s allegation that *Eastwood* claimed a mold, *Eastwood* actually claimed a hot top for receiving a mold. The combination of a mold and hot top were not claimed. As such, issues of claim infringement against an accused infringing device would not hinge upon indefinite dimensions of a mold usable therewith. Had *Eastwood* placed similar variable range language on the hot top, had *Eastwood* claimed the mold, or claimed the combination of the mold and hot top, indefiniteness would have existed on the claimed invention. In contrast, the instant claims have open-ended approximation range limits on a claimed combination component. Therefore, the indefinite rejections are maintained (it is also notable that applicant *Eastwood*, having prevailed at the Board on the art rejections, elected to remove the disputed open-ended language before patent issuance in spite of prevailing on the indefinite issue).

If applicant wishes multiple range variation, applicant could define the current claim ranges coupled with successively narrower dependent claims.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exmr. Michael E. Butler whose telephone number is (703) 308-8344.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh, can be reached on (703) 306-4173. The fax number for the Group is (703) 305-7687.



Michael E. Butler

Examiner



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